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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,298	07/14/2003	Howard L. Stein	Stein-1	6304

7590

01/13/2006

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47 Rice Road  
Wayland, MA 01778

EXAMINER
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AGARWAL, MANUJ

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/619,298	<b>Applicant(s)</b> STEIN, HOWARD L.	
	<b>Examiner</b> Manuj Agarwal	<b>Art Unit</b> 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/29/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. Thus, US. 4,010,743 has not been considered.

Furthermore, item # 1283592 at link [www.mcSports.com](http://www.mcSports.com) did not bring up any results, nor did a search for "Medium Thermal Massage Ball" on <http://info.product-finder.net>.

### ***Drawings***

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

Under CFR 1.83(a) the drawings must show every feature of the invention specified in the claims. Therefore, the heating element, mat, and storage device must

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be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### ***Specification***

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slade (<http://www.ionet.net/~tslade/chinball.htm>) in view of Leason (6,866,776).

Slade teaches the pressing and rolling of an iron freestanding Chinese Health Ball with a diameter of 1.75 inches against the underside surface of the foot and a rigid surface. Slade lacks the application of a therapeutic hot or cold treatment and a weight dimension. Leason et al. teaches the heating of a steel massage ball 36 by heater 120 (col. 4 lines 54-55). Due to the fact that the claimed massage ball is also made of steel, it follows that this massage ball 36 must fall within the realm of 6 to 24 ounces because it is within the claimed range of diameter. Steel was selected by Leason as the material of composition for its heat absorbing and retaining ability (col. 4 line 62-65) and would not deform during the said massage. It would have been obvious to provide the

massage ball of Slade with a steel composition and a heating element as taught by Leason in order to provide an effective heated massage to the underside of a user's foot.

Claims 2-6,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slade in view of Leason as applied to claim 1 above, and further in view of Moriyama et al. (US 4,082,089).

Regarding claim 2, the amount of heat delivered by heater 120 is adjusted by a rheostat or transistor circuit that allows the selection of a "warm" or "hot" temperature (col. 6 lines 53-58). Due to the fact this apparatus is intended to provide therapeutic warmth, it follows that a temperature of 115°F is capable of being provided to the massage ball. The actual means of heating the ball is irrelevant. Furthermore, because the ball of Leason is taught to be comprised of a heat-absorbent material suitable for retaining absorbed heat, it follows that the therapeutic warmth is provided for at least three minutes in a room temperature between 65-75°F. Note that the warmer the air temperature, the less the amount of heat that will escape from the ball's surface.

Slade in view of Leason lacks a means for providing a therapeutic cold massage. Moriyama et al. teaches a freely rotatable massage ball 17 capable of being pressed and rolled between a rigid surface and the underside of the foot that is cooled in an electric refrigerator, a device that includes a means for adjusting the temperature. Because Moriyama et al.'s apparatus is intended to provide therapeutic cold, the temperature of the refrigerator would be at least 55°F. Therefore the massage ball is capable of being cooled from an air temperature of 65°F to 75°F to any temperature

desired dependent on practical considerations of intended use including the specific needs of the patient. Furthermore, because the ball is said to be made of a material with a relatively large specific heat, a measure of how well a substance preserves its temperature, it is inherent that the cold will be retained by the ball during the application as said therapeutic cold massage. It would have been obvious to one of ordinary skill at the time the invention was made to provide the massage ball of Slade in view of Leason with a means to provide a therapeutic cold massage as taught Moriyama et al. to provide cold thermal stimulation to the underside of a user's foot.

Regarding claim 3, Leason's massage ball is made of a material suitable for retaining absorbed heat. Because heater 120 can be adjusted to provide a range of temperatures, it follows that the massage ball is capable of being heated and retained at a temperature above 95 °F. The therapeutic cold of Moriyama et al. is provided by an adjustable refrigerator at a preferred temperature of 4°C, or 40°F, which is below 70°F.

Regarding claim 4, Slade states that the Chinese Health Balls are smooth metal.

Regarding claim 5, Slade states that the Chinese Health Balls are 1.75 inches in diameter. Because Slade in view of Leason is composed of steel, it follows that the ball must weight between 12 and 14 ounces because it is made of an identical material of composition as the claimed massage ball.

Regarding claim 6, Leason's massage ball is composed stainless steel. Due to the fact that he does not clarify the type of stainless steel from which the ball is composed, it is assumed to be composed of 304 Stainless Steel, the most common

18/8 form. Stainless steel 316, 420 and 440 are mainly used in surgical cutlery ([http://en.wikipedia.org/wiki/Stainless-steel#Types\\_of\\_stainless\\_steel](http://en.wikipedia.org/wiki/Stainless-steel#Types_of_stainless_steel)).

Regarding claim 8, the ball of Moriyama et al. is magnetized (col. 2 line 8).

Claims 9-13,15,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slade in view of Leason in further view of Moriyama et al. as applied to the claims above, and further in view of Chan (2003/0004443).

Regarding claim 9, see rejection of claims 1 and 2. Chinese Health Balls are available individually packaged. The combination of references lack instructions for the application of the massage ball to the underside of the foot. Chan discloses a sole massage device that includes a booklet that instructs a user how to correctly use the device (paragraph 6). It would have been obvious to one of ordinary skill at the time the invention was made to provide the apparatus of Slade, Leason and Moriyama with an instruction booklet as taught by Chan in order to facilitate the correct usage of the massage ball.

Regarding claim 10, see rejection of claim 3.

Regarding claim 11, Slade states that Chinese Health Balls can be hollow or solid.

Regarding claims 12,13,15 see rejection of claims 5,6,8.

Regarding claim 16, Leason includes heater 120 for heating the massage ball.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slade in view of Leason in further view of Moriyama et al. in further view of Chan

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as applied to claims 2-6,8,9-14,15,16 above, and further in view of Kobayashi. (US 20040013849).

Slade in view of Leason in further view of Moriyama et al. lacks a non-skid mat with magnetic properties. Kobayashi discloses a mat comprising fabric 5 which serves as a non-skid surface and magnets 20. It would have been obvious to one of ordinary skill at the time the invention was made to provide the device of Slade in view of Leason in further view of Moriyama et al. with a magnetic non-skid mat as taught by Kobayashi in order to prevent the ball from slipping from the underside of the foot during its massage application.

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slade in view of Leason in further view of Moriyama et al. in further view of Chan as applied to claims 9-13,15,16 above, and further in view of Holland et al. (US 2002/0175100).

The above combination of references lack a storage device having magnetic properties. Such a device is disclosed by Holland et al. who discloses a pouch with an enclosed magnet. It would have been obvious to one of ordinary skill at the time the invention was made to provide the apparatus of Slade, Leason, Moriyama and Chan with a magnetic container as taught by Holland et al. to provide a secure and reliable means to contain the massage ball.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



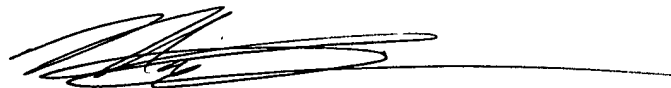
1. US 5263474. Agader. Foot Massaging Device. Massage balls for application to the underside of the foot
2. US 2466470. Norris. Reducing Apparatus. Massage ball
3. US 5725484. Burnham. Manual Personal Massager. Massage balls for application to the underside of the foot.
4. US 4846159. Anzai et al. Massaging Apparatus. Apparatus comprising massage balls capable of application to underside of the foot.
5. US 2003/0144616. Henderson. Massage Device. Device including massage balls for application to underside of the foot.
6. US 2004/0082886. Timpson. Therapeutic device for relieving pain and stress. Massage balls for application to the underside of the foot.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manuj Agarwal whose telephone number is (571) 272-4368. The examiner can normally be reached on Mon to Fri 9:00 AM 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen K. Cronin can be reached on (571) 272-4536. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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